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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,681	11/25/2003	John I. Shipp	115.0003-03000	5638

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EXAMINER

O'CONNOR, CARY E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,681	<b>Applicant(s)</b> SHIPP ET AL	
	<b>Examiner</b> Cary E. O'Connor	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-50 is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>112503</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7, 8, 12-18, 20, 21, 25-30, 32, 33, 37 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-29, 32 and 33 of U.S. Patent No. 6,652,545. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Claims 1-5, 14-18 and 27-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 7 or 19 of copending Application No. 10/706,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 8, 14, 15-17, 20, 27-29, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Elliott et al (4,041,931). Elliot shows a ligation clip 10 comprising a mid-longitudinal axis, a distal end, a proximal end opposite the distal end, an upper support member 28 extending between the ends, and a lower support member 28 extending between the ends. The lower support member is opposite the upper support member in a vertical plane parallel to the mid longitudinal axis. A connector 22, at the proximal end of the clip joins and biases the members

towards one another. The upper and lower support members have a bend section 16, 18, extending 360 degrees, proximate the distal end. As to claims 8, 21 and 33, the connector includes a coil spring.

Claims 1-4, 7-9, 11, 12, 14-17, 20-22, 24, 25, 27-29, 32-34, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Perlin (4,444,187). Perlin shows a ligation clip comprising a mid-longitudinal axis, a distal end, a proximal end opposite the distal end, an upper support member 22 extending between the ends, and a lower support member 21 extending between the ends. The lower support member is opposite the upper support member in a vertical plane parallel to the mid longitudinal axis. A connector 23, at the proximal end of the clip joins the members. The upper and lower support members have a bend section 41, 31 greater than 180 degrees proximate the distal end. The connector biases the support members toward one another into a closed position with a force greater than the force greater than the force needed to move the support members into contact with one another. As to claims 11, 24 and 36, note the paragraph bridging columns 6 and 7. As to claims 12, 25 and 37, note the clip applier 60.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin (4,444,187) in view of Schmidt et al (5,757,420). Schmidt teaches that it is highly desirable to have a clamping force of 180-225 grams for a surgical clip. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the clip of Perlin to have a clamping force of 180-250 grams, in view of the teaching of Schmidt that this range of clamping force is highly desirable.

Claims 13, 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin (4,444,187) in view of Braun (4,854,317). The applicator of Perlin does not include a magazine for holding and dispensing a plurality of clips. The applicator of Braun is used to apply clips that are biased to a closed position and includes a magazine of a plurality of clips. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the applicator of Perlin with that of Braun, so that the applicator could be used multiple times without having to withdraw it from the body for reloading.

Claims 6, 19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin (4,444,187). Perlin discloses the claimed invention except for the separation distance between the clamping surfaces of not more than 0.75 mm in an open and updeployed condition. It would have been an obvious matter of design choice to form for the separation distance between the clamping surfaces of not more than 0.75 mm in an open and updeployed condition, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as

being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

***Allowable Subject Matter***

Claims 39-50 are allowed.

***Specification***

The disclosure is objected to because of the following informalities: In the background of the invention "6,652,539" should be changed to --6,652,545--.

Appropriate correction is required.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cary E. O'Connor  
Primary Examiner  
Art Unit 3732

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